

PATENT

Atty. Dkt. No. WEAT/0214.Y1

**REMARKS**

This is intended as a full and complete response to the Final Office Action dated May 13, 2005, having a shortened statutory period for response set to expire on August 13, 2005.

Claims 1-5, 8-21 and 56-61, 63-68, 70-74, and 76-77 remain pending in the application and are shown above. Claims 69 and 75 have been cancelled. Claims 1, 3-5, 8, 12, 19-21, 69, 75 and 77 stand rejected. Claims 56-64, 66-68, 70, and 71 are allowed, and claims 2, 9-11, 13-18, 65, 75, and 77 are objected to. Reconsideration of the rejected claims is respectfully requested for reasons presented herein.

Claims 1, 3-5, 12, 72-74 and 76 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by *Diefendorf*. The Examiner states that "each of the 'tongs' are open at both the upper and lower edges to allow for insertion of the pipe."

Applicant respectfully traverses this rejection. Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475 (Fed. Cir. 1994). *Diefendorf* discloses a two piece clamp (2, 3) connected around a pipe by bolts. The clamps have an axial bore that extends through the clamp to receive the pipe. Thus, the axial bore is what allows the insertion of the pipe and is not a separate opening. *Diefendorf* does not teach, show, or suggest an opening is provided from the peripheral surface to the axial passage of each of the first and second tongs to allow the introduction of the tubular into the axial passage of each of the first and second tongs, as recited in claim 1. Because *Diefendorf* fails to disclose at least one element of claim 1, withdrawal of the rejection is respectfully requested.

With respect to claim 72, *Diefendorf* does not teach, show, or suggest a first gripping apparatus for gripping the first tubular, the gripping apparatus having hydraulically actuatable clamping elements. Withdrawal of the rejection is respectfully requested.

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Claims 8, 19-21 and 69 stand rejected under 35 USC § 103 (a) as being unpatentable over *Diefendorf*, in view of *Smith* or *Jurgens*.

Applicant respectfully traverses this rejection. *Diefendorf*'s pipe screwing device is used for securing pipes in trenches. The device has a handwheel that extends out of the trench for turning the clamp. One of the advantages of the device is that it "gives sufficient power to set up the pipe with little effort on the part of the workman and the rod being extended above the trench makes the operation of the device possible in a convenient position." Because the *Diefendorf* device is designed to be easily assembled in the trench and easily moved from pipe to pipe, it would not have been obvious to add a motor to the handwheel of *Diefendorf*.

Moreover, both *Smith* and *Jurgens* teach a motor attached to the same tong that the motor is rotating. However, *Diefendorf* teaches attaching the pinion to the non-rotating tong. Therefore, it would not have been obvious to combine the motor of either *Smith* or *Jurgens* with the pipe screwing device of *Diefendorf*. The Federal Circuit has held that it is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v. Barnes-Hind, Inc., 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986). The references, neither alone nor in combination, teach, show, or suggest the at least one pinion meshing with the gear in such a way that the first clamping member and the second clamping member can be rotated relative to one another by rotating the at least one pinion and wherein the first clamping member comprises hydraulically actuated jaws mounted within the gear about an axial passage extending through the gear, as recited in claim 19. Withdrawal of the rejection is respectfully requested.

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

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Having addressed all issues set out in the Final Office Action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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